UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/588,534	06/07/2000	Ronnie Dale Johnson	BS99-090	9205

7590   05/12/2005

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ART UNIT	PAPER NUMBER
3627	

DATE MAILED: 05/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	09/588,534	JOHNSON ET AL.
	Examiner	Art Unit
	Elaine Gort	3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>04 February 2005</u>.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1 and 3-20* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1+3-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

Double Patenting

1.   The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2.   **Claims 1 and 3-20 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-35 of copending Application No. 09/996,806 in view of Marchbanks et al. (US Patent 6,266,401).** Although the conflicting claims are not identical, they are not patentably distinct from each other because '806 shows all steps of the claims except authorizing the release of the batch of hold bills, printing the hold bills as customer bills and sending the customer bills to the customer, Marchbanks et al. discloses in column 4 lines 41+ that it known in the art to begin final production of bills after the accuracy of the bills is verified to check the data on the bills prior to sending.

This is a <u>provisional</u> obviousness-type double patenting rejection.

Claim Rejections - 35 USC § 112

3.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly
> claiming the subject matter which the applicant regards as his invention.

**4.   Claims 1, 3-10, 18 and 20 are rejected under 35 U.S.C. 112, second
paragraph, as being indefinite for failing to particularly point out and distinctly
claim the subject matter which applicant regards as the invention.**

Claim 1 recites the limitation "the accuracy" in line 23. There is insufficient
antecedent basis for this limitation in the claim.

Claim 5 recites the limitation "the displaying step" in line 1. There is insufficient
antecedent basis for this limitation in the claim. The term "step" should be omitted.

In claim 10 it is unclear if a new database is being claimed or if reference to the
database claimed in claim 1 line 11 is being referred to. For purposes of this action it is
assumed that the database of claim 1 is being referred to.

Claim 18 recites the limitation "the database" in line 1. It is unclear which
database this is referring to asthere are two databases claimed in claim 11, one relates
to tax rate information (line 5) and the other to account charges (line 7).

Claim 20 recites the limitation "the accuracy" in line 1. There is insufficient
antecedent basis for this limitation in the claim.

Claim 20 recites the limitation "the basis" in line 8. There is insufficient
antecedent basis for this limitation in the claim.

Claim 20 recites the limitation "the tax" in line 11. It is unclear if this calculated

tax is the tax on the hold bill that is claimed in claim 1 or an entirely newly calculated

tax. For purposes of this action it is assumed to state "a tax".

Claim Rejections - 35 USC § 103

5.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6.   **Claims 1 and 3-20 are rejected under 35 U.S.C. 103(a) as being**

unpatentable over Marchbanks et al. (US Patent 6,266,401) in view of Heindel et al.

(US Patent 6,304,857) and Examiner's Official Notice.

Marchbanks et al. discloses the claimed method of verifying taxes on a batch of

customer bills but is silent regarding utilization of an outsourced billing entity (3rd party)

to generate "hold" bills and to carry out the final distribution of bills; the specific step of

performing a recalculation for verification purposes; and the displaying of worksheet

information.

Heindel et al. discloses that it is known in the art to provide outsourced billing

utilizing a network to have another company assist in the preparation of bills ("hold

bills") such as to generate bills and to provide final distribution of bills in order to reduce

costs and/or resources required for billing (see abstract and figures 1-5).

Examiner takes Official Notice that it is notoriously old and well known in the art of verification to perform a recalculation in much the same way as the initial calculation to determine if the first calculation is accurate.

Examiner takes Official Notice that it is notoriously old and well known in the art of data processing to display database information in the form of a worksheet on a computer monitor to provide users the ability to view and manipulate data within the database.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the method of verifying taxes of Marchbanks et al. with the outsourcing for assistance in generating and distributing bills as taught by Heindel et al. in order to reduce costs and resources required for billing.

It further would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the method of verifying taxes of Marchbanks et al. and Heindel et al., as modified above, with the performance of a recalculation and the display of data in the form of a worksheet as taught by Examiner's Official Notice in order to determine if the initial tax calculation is correct and to provide the ability to view and manipulate data within the database, respectively.

Note for clarfication: in this modified scenario of above, the third party carries out the generation of the "hold" bill and waits for the verification, which is done by the telecommunications service provider, and after verification is completed the 3rd party would then do the final distribution of the bills (i.e. the telecom provider is only

outsourcing the generation of the hold bill and the distribution of the verified bills, not the verification of the taxes on the bills).

For clarification of the rejection the following explanation is provided:

A method of verifying taxes on a batch of customer telecommunications bills initially generated, and ultimately to be sent out, by an entity other than a telecommunications service provider (Marchbanks discloses the method of generating invoices including an initial tax calculation which is then verified for accuracy and once verified then printed for final production, see column 4 lines 41+; The Examiner has used Official Notice to outsource only the steps of generating the bills including an initial tax calculation and the final distribution of bills, therefore the telecom provider maintains the tax verification step), comprising the steps of:

Downloading, from a mainframe computer, to a local server operated by the telecommunications service provider (the prevalidated bill information would be accessible to the telecom provider from the 3rd party in order for the telecom provider to verify the invoiced information as Marchbanks discloses in column 4 lines 41+, both Marchbanks and Heindel disclose the use of networked systems to transfer data; Heindel discloses the use for transferring data between the 3rd party and the telecom provider), billing data associated with customer accounts, the billing data having been used by the entity other than the telecommunications service provider to generate hold bills that are scheduled to be sent as customer bills to customers of the telecommunications service provider, the hold bills including hold bill tax charges that were independently calculated by the entity other than the telecommunications service

provider (the 3rd party generates the hold bills which would include tax charges and other billing data associated with customer accounts which the service provider would use to verify the billing is correct);

Populating a database with a portion of the billing data (This is done when the preliminary bill data from the 3rd party is used in the verification step of Marchbanks column 4 lines 41+ when the service provider would access the information to verify it);

Performing pre-calculation functions on another portion of the billing data and further populating the database with results of the pre-calculation functions (such as in Marchbanks where information regarding tax rates is gathered, for example see figure 16B with categorized taxes, discounts, charges, etc..);

Displaying predetermined categories of information stored in the database the categories of information encompassing at least a subset of the result of the precalculation functions (such as in Marchbanks in figure 16B which discloses predetermined categories as multiple accounts that are charged on one account);

Independently calculating, by the telecommunications service provider, calculated tax results for each of several charges in the billing data utilizing the billing data populated in the database, and storing the calculated tax results in the database (Marchbanks discloses "verification" of taxes in column 4 lines 41+; Examiner has taken official notice of performing a recalculation in order to ensure the initial calculation is accurate; this independent recalculation would be performed by the service provider to verify the 3rd parties calculations to ensure accuracy);

Receiving entry of an account number into a worksheet being displayed and

automatically filling the worksheet with the calculated tax results for the account number

(Marchbanks inherently receives an entry of the account number when the invoice data

is accessed to be verified; Examiner took official notice that it is old and well known to

use worksheets to display data allow users the ability to view and manipulate data;

when the telecom provider receives the billing data for verification the account number

would be included with the account information);

Comparing the calculated tax results displayed within the worksheet with the hold

bills tax charges on the customer hold bills to verify the accuracy of the hold bills tax

charges (Examiner took official notice of recalculating to verify accuracy, the

recalculated amount is then compared to the initial calculation and if equal then the hold

bill is verified; Marchbanks is silent on precisely what steps are carried out to verify

taxes on the hold bills but states they are verified);

When the calculated tax results match the hold bills tax charges, authorizing the

entity other than the telecommunications service provider to release the batch of hold

bills, print the hold bills as customer bills and send the customer bills to the customers

(Marchbankes discloses that after the accuracy of the hold bills are verified the invoices

are printed an distributed column 4 lines 49+; in this scenario when the recalculated

value by the service provider is found to match the 3rd parties value the printing of the

invoices is authorized by the service provider to the 3rd party);

(Regarding claim 3) where the pre-calculation functions include summing toll

telephone charges (see Marchbanks figure 16B that "pre-calculates" charges for

services including telephone calls, Examiner takes Official Notice that the charging of

toll telephone calls is notoriously old and well know in the art of telecommunications in

order for the telecom company to receive payment. Therefore it would be obvious to

charge for toll calls to receive payment. Note that the verification calculation would

carry out similar calculations as initially done as shown in figures 16A-G of

Marchbanks);

(Regarding claim 4) where the predetermined categories describe elements of

individual charges (for example see itemization of calls in Marchbanks figure 16C);

(Regarding claim 5) where the display step is performed on a computer

(Examiner has taken official notice to view data in the form of a worksheet on a

computer monitor for the purpose of viewing and modifying data);

(Regarding claim 6) where the computer is in communication with an electronic

data network (for example, Marchbanks discloses a network in figure 6 and Heindel et

al. discloses the transfer of billing info over a network in figure 1).

(Regarding claim 7) further comprising loading the database with tax rate

information (for example, tax rate information is loaded in Marchbanks to calculate

invoices as shown in figures 16A-G);

(Regarding claim 8) further comprising electronically saving the tax results (the

results would be saved by the computer in order to be compared to the initial calculated

value);

(Regarding claim 9) further comprising utilizing the calculated tax results for

resolving questions (for example if the tax values do not match and the bill is not verified

the results would be used to determine what is incorrect in order to correct it so it can be verified and sent out);

(Regarding claim 10) where the local server and database are integrated in a single machine (it is unclear in Marchbanks if one single machine performs the functions of being a server and storing data, but the usage of computers as servers and datastorage is notoriously old and well known in the art of networking to provide speedy access to data over a network);

(Regarding claim 11) maintaining a tax rate database in communication with a data network (Marchbanks, such as shown in figures 16A-G, discloses the use of tax data which inherently must be obtained from a database in order to be entered into a bill);

maintaining a database that includes account charges (data used in the bills as shown in Marchbanks figures 16A-G includes account charges which inherently must be obtained from a database in order to be entered into the bill);

automatically applying the tax rate information to the account charges and storing a calculated tax result, the calculated tax result being independently calculated by the second entity (or "service provider" as referred to above) (the telecom provider in re-calculating, as modified above by Examiner's official notice, would apply the tax requirements to the charges in order to verify the tax due);

receiving entry of an account number into a worksheet being displayed and automatically filling the worksheet with the calculated tax result on a computer that is in communication with the data network (Marchbanks inherently receives an entry of the

account number when the invoice data is verified; Examiner took official notice that it is

old and well known to use a worksheets to display data to allow users the ability to view

and manipulate data; when the telecom provider receives the billing data for verification

the account number would be included with the account information);

comparing the calculated tax result displayed in the worksheet with the hold bill

taxes appearing on the hold bill (Examiner took official notice of recalculating to verify

accuracy, the recalculated amount is then compared to the initial calculation and if equal

then the hold bill is verified; Marchbanks is silent on precisely what steps are carried

out to verify taxes on the hold bills but states they are verified);

when the calculated tax result displayed in the worksheet matches the hold bill

taxes, the second entity authorizing the first entity to print and to send the hold bill as a

customer bill (Marchbanks discloses that after the accuracy of the hold bills are verified

the bills are printed and distributed in column 4 lines 49+; in this scenario when the

recalculated value by the service provider is found to match the 3rd parties value the

printing of the bills is authorized);

(Regarding claim 12) where the step of maintaining the database includes

downloading account information from a mainframe computer (Examiner takes official

notice that the use of mainframe computers for obtaining data from is notoriously old

and well known in the art of computer systems to provide simultaneous support to

many users connected to the computer by terminals. Therefore it would have been

obvious to one of ordinary skill in the art to maintain account information and other

billing data on a mainframe computer to provide simultaneous support to many users

connected to the computer system);

(Regarding claim 13) where the account information includes pre-bill and

demand print data (the account information of Marchbanks includes usage data which is

data used for the preparing and printing of bills, for example see data used in figures

16A-G);

(Regarding claim 14) further comprising supplying the tax rate information to the

mainframe computer (Examiner has taken official notice that the use of mainframe

computers for obtaining data from is notoriously old and well known in the art of

computer systems to provide simultaneous support to many users connected to the

computer by terminals. Therefore it would have been obvious to one of ordinary skill in

the art to maintain account information and other billing data such as tax rate

information on a mainframe computer to provide simultaneous support to many users

connected to the computer system. Therefore it would have been necessary to supply

tax rate information to the mainframe computer in order for it to provide it);

(Regarding claim 15) further comprising scanning the hold bill and storing an

image thereof (Examiner takes official notice that the use of scanning and character

recognition of printed matter is notoriously old and well known in the art of computer

systems to provide an electronic copy of the document and also the ability to determine

which alphanumeric characters or punctuation marks the shapes represent. Therefore

it would have been obvious to one of ordinary skill in the art to scan in printed copies of

the "hold" bills generated by the 3rd party and to use character recognition as taught by

Examiner's Official Notice in order to provide an electronic copy of the printed bill with

the ability to determine what the invoices contain for verification against the service

providers recalculated tax value.);

(Regarding claim 16) further comprising applying optical character recognition

software to the image and storing a file representative of characters obtained (Examiner

has taken official notice that the use of scanning and character recognition of printed

matter is notoriously old and well known in the art of computer systems to provide an

electronic copy of the document and also the ability to determine which alphanumeric

characters or punctuation marks the shapes represent. Therefore it would have been

obvious to one of ordinary skill in the art to scan in printed copies of the "hold" bills

generated by the 3rd party and to use character recognition as taught by Examiner's

Official Notice in order to provide an electronic copy of the printed bill with the ability to

determine what the invoices contain for verification against the service providers

recalculated tax value.);

(Regarding claim 17) further comprising electronically comparing at least a

portion of the file with the calculated tax result (Examiner has taken official notice that

the use of scanning and character recognition of printed matter is notoriously old and

well known in the art of computer systems to provide an electronic copy of the

document and also the ability to determine which alphanumeric characters or

punctuation marks the shapes represent. Therefore it would have been obvious to one

of ordinary skill in the art to scan in printed copies of the "hold" bills generated by the 3rd

party and to use character recognition as taught by Examiner's Official Notice in order to

provide an electronic copy of the printed bill with the ability to determine what the

invoices contain for verification against the service providers recalculated tax value.);

(Regarding claim 18) where the database is in communication with a local server

(Both Marchbanks and Heindel disclose the use of networked systems to share and

transfer data; in this modified scenario the billing data used by the 1st entity to prepare

the prevalidated bill would use the same billing data that the 2nd entity (or service

provider) would use to recalculate for verification purposes. This data would be shared

over a network and is accessible by the use of servers.);

(Regarding claim 19) further comprising using the calculated tax result to identify

errors on the hold bill (Marchbanks discloses that after the accuracy of the hold bills are

verified the invoices are printed and distributed in column 4 lines 49+; in this scenario

when the recalculated value by the service provider is found to not match the 3rd parties

value, an error is identified and the bill is not approved for distribution);

(Regarding claim 20) A method of verifying the accuracy of tax charges on a hold

bill generated for a customer account by an outsourced entity, the hold bill being one

that is scheduled to be sent by the outsourced entity as a customer bill to a customer

upon verification, by an entity providing service, other than billing service, directly to the

customer, of the accuracy of the tax charges indicated on the hold bill (Marchbanks

discloses the method of generating bills including an initial tax calculation which is then

verified for accuracy and once verified then printed for final production, see column 4

lines 41+; The Examiner has used Official Notice to outsource only the steps of

generating the bills including an initial tax calculation and the final distribution of bills,

therefore the telecom provider maintains the tax verification step), the method

comprising the steps of:

downloading data to the entity providing service, other than billing service,

including customer charges, that is the basis for hold bill generation, to a local server

(the service provider in the modified scenario would download account data and tax

data to perform a recalculation for verification purposes);

on the local server, automatically determining which customer charges are

subject to taxation (the service provider in the modified scenario would download

account data and tax data to perform a recalculation for verification purposes and would

determine which charges are subject to taxation, for example see figures 16A-G

illustrating different tax categories);

on the local server, automatically calculating the tax for the customer charges

subject to taxation and storing calculated tax results (the service provider in the

modified scenario would download account data and tax data to perform a recalculation

for verification purposes);

receiving entry of an account number in a worksheet being displayed and

automatically filling the worksheet with the calculated tax results on a user computer

(Marchbanks inherently receives an entry of the account number when the invoice data

is accessed to be verified; Examiner took official notice that it is old and well known to

use worksheets to display data to allow users the ability to view and manipulate data;

When the telecom provider receives the account billing data for verification the account

number would be included with the account information.);

on the local server, comparing the calculated tax results displayed in the worksheet to the tax charges on the hold bill (Examiner took official notice of recalculating to verify accuracy, the recalculated amount is then compared to the initial calculation and if equal then the hold bill is verified);

where the hold bill is generated on a mainframe computer operated by the outsourced entity, the tax charges on the hold bill are independently calculated by the outsourced entity, the tax charges on the hold bill are independently calculated by the outsourced entity, the local server is operated separately from the mainframe computer by the entity providing service, other than billing service, and the entity providing service, other than billing service, independently calculates the calculated tax results (Marchbanks discloses the method of generating invoices including an initial tax calculation which is then verified for accuracy and once verified then printed for final production, see column 4 lines 41+; The Examiner has used Official Notice to outsource only the steps of generating the invoices including an initial tax calculation which is called a "hold bill"); and

where the calculated tax results match the tax charges on the hold bill, authorizing the outsourced entity, by the entity providing service, other than billing service, to send the hold bill as a customer bill to the customer (Marchbankes discloses that after the accuracy of the hold bills are verified the invoices are printed an distributed column 4 lines 49+; in this scenario when the recalculated value by the service provider is found to match the 3rd party's value the printing of the invoices is authorized and the 3rd party would send the bills to customers).

Response to Arguments

7.   Applicant's arguments with respect to claims 1 and 3-20 have been considered

but are moot in view of the new ground(s) of rejection.

See above clarification for details.

Conclusion

8.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Elaine Gort whose telephone number is (571)272-6781.

The examiner can normally be reached on Tuesdays and Fridays from 7:00 am to 7:30

pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Robert Olszewski, can be reached at (571)272-6788. The fax phone

number for the organization where this application or processing is assigned is

(703)872-9326.

Any inquiry of a general nature or relating to the status of this application or

proceeding should be directed to the receptionist whose telephone number is (703)308-

1113.

Elaine Gort
Examiner – Art Unit 3627

May 7, 2005